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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 1020/0132PUS1	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>April 4, 2008</u> Signature  Typed or printed name <u>Martin R. Geissler</u>		Application Number 10/721,358 First Named Inventor GLIENICKE et al. Art Unit 2885	Filed 28 Nov 2003 Examiner
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>51011</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____		 Signature <u>Martin R. Geissler</u> Typed or printed name <u>1.703.621.7140</u> Telephone number <u>April 4, 2008</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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APR 04 2008

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Haiko GLIENICKE et al.

Confirmation No. 6146

Application No.: 10/721,358

Art Unit: 2885

Filed: 26 Nov 2003

Title: CONTROL ELEMENT

Examiner: J. Y. Choi

Attorney Docket No.: 1020/0132PUS1

REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW**MS AF**Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In addition to the Notice of Appeal which is being concurrently filed, Applicants respectfully request a Pre-Appeal Brief Conference to consider the issues raised in the Office Action dated October 4, 2007, that finally rejected claims 1-19. Claims 20 and 21 stand withdrawn as allegedly being directed to a non-elected invention.

A. Claim Rejection under 35 U.S.C. § 102

Claims 1, 4-9, and 17 stand rejected under 35 U.S.C. 102(e) as being anticipated by Zysnarski et al. (US 6,590,174). This rejection is respectfully traversed.

The Office Action mischaracterizes the features disclosed by Zysnarski and fails to establish that all of the claimed features are disclosed by Zysnarski.

Claim 1: Independent claim 1 recites, in part, a control element including "a light rotor that extends towards the optical light guide to a height necessary for light transport; and a light source located below the light rotor."¹

In comparison, Zysnarski specifically discloses that the light which is emitted from the lights sources 22 is emitted from the gap 38, which surrounds the knob 14, so that the knob 14 appears to be floating on the light. Zysnarski does not disclose that the knob 14 itself transports light from the light sources 22, or for that matter, that the knob 14 extends toward the light diffuser 16 to a height necessary for light transport. Instead, Zysnarski specifically discloses that an interior surface 58 of the knob 14 reflects light, which then ends up being transmitted through the gap 38, which surrounds the knob

¹ See, e.g., specification at page 3, paragraph [0017].

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14.² Thus, the knob 14 reflects light, rather than transporting light. Accordingly, Zysnarski clearly fails to disclose at least the claimed "*a light rotor.*"

The knob 14 of Zysnarski also does not extend from the light source 22 toward the light diffuser 16 to a height for light transport. Instead, the light diffuser 16 extends from the light source 22 towards the knob 14. Accordingly, Zysnarski does not disclose at least "*a light rotor that extends towards the optical light guide to a height necessary for light transport*" as recited in claim 1.

Claim 8: Zysnarski clearly fails to disclose at least "wherein the optical light guide is fixed relative to the control element" as recited in claim 8. In Fig. 1 of Zysnarski, the optical light guide 16 engages the panel 24, while the alleged light rotor (i.e., knob 14) of the control element rotates with respect to the light guide 16. Thus, Zysnarski clearly fails to disclose at least "*wherein the optical light guide is fixed relative to the control element.*"

B. Claim Rejections under 35 U.S.C. § 103

Claims 1, 2, and 4-17 stand rejected under 35 U.S.C. 103(a) over Glienicke (US 6,224,221) and claims 2, 3, and 10 stand rejected under 35 U.S.C. 103(a) over Zysnarski et al. These rejections are respectfully traversed.

The Office Action mischaracterizes Glienicke or Zysnarski, fails to establish that all of the claimed features are disclosed by Glienicke or Zysnarski, and fails to respond to all of Applicants' traversal positions.

Claim 1: Independent claim 1 recites, in part, a control element including "*a light rotor that extends towards the optical light guide to a height necessary for light transport; and a light source located below the light rotor.*"³

The Office Action misinterpreted the features of the "*light rotor*" as being comparable to the overall knob assembly 1 of Glienicke.⁴ The Office Action also has not responded to Applicants' traversal of this position, and has not explained how the overall knob assembly 1 of Glienicke is comparable to the claimed light rotor.

It is noted that, where Applicant traverses any rejections, the Examiner should, if he repeats the rejection, take note of the Applicant's argument and answer the substance of

² See col. 5, lines 1-16; see also col. 4, lines 57-67.

³ See, e.g., specification at page 3, paragraph [0017].

⁴ See Office Action at page 5.

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it.⁵ Thus, the Examiner should have responded to all of Applicant's traversal positions and answered the substance of the arguments.

The Office Action also fails to establish that Glienicke discloses or suggests at least "an optical light guide formed from a single piece that includes two parts, the two parts being partially separated by an annular slot, such that parts of the panel engage or project into the slot" as recited by claim 1.

The Examiner alleged that the combination of the light transmitting body 6 and the light transmitting body 11 teaches the optical light guide. The Examiner acknowledged that Glienicke fails to specify that the first and second optical light guide are formed from a single piece, but alleged that it would have been obvious to combine the first and second light-transmitting body to be a single piece. However, the stated motivation for modifying the teachings of Glienicke merely is an unsupported conclusory statement, which fails to properly establish a *prima facie* case. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness".⁶ Glienicke clearly fails to suggest such a modification. In Fig. 1 of Glienicke, the light transmitting bodies 6, 11 clearly are not partially separated, as recited in claim 1. Instead, the light transmitting bodies 6, 11 are completely separate. Glienicke states that: "the light-transmitting body 6 terminates with its peripheral part 8 in a transparent housing section 9. This housing section 9 includes ... a light-transmitting body 11 of the rotatable knob 1 firmly emplaced in the housing section 9 between the scale 10 and the peripheral part 8 of the light-transmitting body 6."⁷

Thus, the Office Action fails to establish that Glienicke discloses or suggests at least "an optical light guide formed from a single piece that includes two parts, the two parts being partially separated by an annular slot, such that parts of the panel engage or project into the slot" as recited by claim 1. Glienicke also does not disclose or suggest that the light transmitting body 6 or the light transmitting body 11 of the housing 9 have an annular slot that partially separates each one into two parts, as recited in claim 1. Further, Glienicke does not disclose or suggest that parts of a panel engage with such a slot or project into a slot. Indeed, the Examiner failed to address or respond to Applicants'

⁵ See M.P.E.P. § 707.07(f).

⁶ See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) (cited with approval in *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (April 30, 2007)).

⁷ See Glienicke at col. 2, lines 38-41; emphasis added.

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position that these features of "the two parts being partially separated by an annular slot, such that parts of the panel engage or project into the slot", as recited in claim 1, are not disclosed or suggested by Glienicke.⁸

Claim 8: Claim 8 recites, in part, "*wherein the optical light guide is fixed relative to the control element.*" As shown in Fig. 1 of Glienicke, the alleged optical light guide 11 is not fixed with respect to the control element 1. Accordingly, Glienicke clearly fails to disclose at least this feature.

Claim 10: Claim 10 recites, in part, "*wherein the optical light guide and the light rotor are formed as a single piece.*" In rejecting claim 10, the Examiner acknowledged that Zysnarski failed to disclose the optical light guide and the light rotor is formed as a single piece. However, the Examiner alleged that Zysnarski suggests that the knob and the light diffuser may appear to be one piece to a user.⁹ The Examiner alleged that it would have been obvious to make both of the light guide (optical light guide & light rotor) into a single piece, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art.¹⁰ However, the Examiner's position is traversed because the proposed modification of Zysnarski clearly would render the prior art invention being modified unsatisfactory for its intended purpose, and there is no suggestion or motivation to make the proposed modification,¹¹ and additionally or alternatively, would change the principle of operation of Zysnarski.¹² Thus, the teachings of Zysnarski are not sufficient to render the claims *prima facie* obvious.

In Fig. 1 of Zysnarski, the optical light guide 16 engages the panel 24, while the alleged light rotor (i.e., knob 14) of the control element rotates with respect to the light guide 16. Thus, the proposed modification of forming the optical light guide 16 and the light rotor (i.e., knob 14) as a single piece clearly would render the device of Zysnarski inoperable, since the light rotor (i.e., knob 14) would no longer be rotatable. In Fig. 2 of Zysnarski, the proposed modification of forming the optical light guide 16 and the alleged light rotor (i.e., knob 14) as a single piece clearly would prevent the alleged light rotor (i.e., knob 14) from being tilted with respect to the optical light guide 16, as shown in Fig. 2. Hence, Zysnarski clearly fails to

⁸ See M.P.E.P. § 707.07(f).

⁹ E.g., see column 3, lines 50-55.

¹⁰ *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

¹¹ See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

¹² See *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

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disclose or suggest at least "wherein the optical light guide and the light rotor are formed as a single piece" as recited in claim 10.


Claim 11: Independent claim 11 recites, in part, a control element including "an optical light guide formed from a single piece having an annular slot provided therein, the annular slot being formed to receive a projection extending from the scale." Glienicke clearly fails to show at least "an optical light guide formed from a single piece." Moreover, neither of the light transmitting bodies 6, 11 of Glienicke have an annular slot provided therein, whereby the slot receives a projection extending from the scale, as recited in claim 11. Furthermore, the Office Action alleged that Glienicke discloses a combined scale and corona illumination, wherein the scale is part of a panel that is designed to work together with the control element. However, the Office Action failed to establish that Glienicke discloses "a scale substantially circumscribing the corona and the rotary knob, the scale being adapted to emit light therefrom" as recited in claim 11. Col. 2, line 41, of Glienicke clearly discloses that the "housing section 9 includes a scale 10." Thus, the scale 10 of Glienicke clearly does not and cannot circumscribes the housing section 9 if the housing 9 includes the scale 10.

C. Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned, at the telephone number listed, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 50-2838 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,


Martin R. Geissler
Registration No. 51011

Muncy, Geissler, Olds & Lowe, PLLC
PO BOX 1364
Fairfax, VA 22038-1364
1.703.621.7140
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